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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,672

Applicant(s)

UERLINGS ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 19-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 19-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Amendment

1. Amendment filed on April 2, 2003 has been entered. Claim 18 has been cancelled.

Claims 1, 2, 19-33 are pending in the application.

Claim Objections

2. Objection to claims 19-29 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn.

Double Patenting

3. Objection to claim 18 under 37 CFR 1.75 as being a substantial duplicate of claim 2 has been withdrawn due to cancellation of the claim.

4. Applicant is advised that should claim 25 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Rejection of claims 2, 18, 22, 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

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7. Claims 19, 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19, line 1, "The method according to claim 18" renders the claim indefinite since it depends on cancelled claim 18.

Claim 23 recites the limitation "the metal-coated surface" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Rejection of claims 1, 19, 21, 24, 28, 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Brownfield (US 6,306,493) has been withdrawn.

10. Claims 1, 2, 19, 20, 21, 24, 27-29, 31, 33 are rejected under 35 U.S.C. 102(b) as anticipated by Berger et al (US 4,740,269).

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Berger et al disclose a method for generating a mark comprising directing a laser beam onto a printed, unprinted paper (coated or uncoated) or if desired a synthetic paper, to make at least one laser mark by partial or complete removal of a *color* layer and/or by effecting structural changes in the *fibers* of the paper, and if desired preserving the laser mark by coating with protective material such as lacquer, color or a hardenable plastic (synthetic resin) (See column 2, lines 19-23; column 3, lines 14-23), printing the laser marked paper and then cutting to form checks or the like (opaque top coating) (See column 3, lines 60-66).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 22, 25, 26, 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al (US 4,740,269) in view of Monaghan (US 5,706,106).

Berger et al, as applied above, fail to teach that the paper treated with laser energy is coated with metal (Claims 22, 25, 26) such as aluminum (Claim 30) before printing.

Monaghan teaches that portions of an embossed holographic imagery on a paper substrate can be covered by non-holographic images such as metal deposition layer such as aluminum for later printing (See column 6, lines 1-6) for creating a new unexpected visual effect (See column 1, lines 43-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have covered engraved images on a paper substrate in Berger et al by non-

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holographic images such as metal deposition layer such as aluminum before printing with the expectation of providing the engraved paper substrate with desired new unexpected visual effect, as taught by Monaghan.

13. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al (US 4,740,269) in view of Yasui et al (US 5,413,629).

Berger et al, as applied above, fail to teach that the fibrous web is a metal-coated prior to treatment with laser energy.

Yasui et al teach that any printable thermosensitive substrate such as paper, plastic, plastic-coated or a metal-coated paper (See column 8, lines 49-53) can be provided with a marking information with high sensitivity and high marking density, i.e., a high contrast between a marked area and a background, by coating first the substrate with a printing ink and then treating the printed substrate with laser energy (See column 2, lines 31-38).

It would have been also obvious to one of ordinary skill in the art at the time the invention was made to have used a metal-coated paper as a paper substrate in a method of Berger et al since Yasui et al teach that any printable thermosensitive substrate such as paper, plastic, plastic-coated or a metal-coated paper can be provided with a marking information with high sensitivity and high marking density.

14. **Claim 32** is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al (US 4,740,269) in view of Sunberg (US 5,989,389).

Berger et al, as applied above, fails to teach that the paper for making banknotes or checks has a basis weight of 40-400 g/m².

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Sunberg teaches that a paper cotton stock having a basis weight of approximately 80 g/m² may be used for making banknotes (See column 8, lines 53-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a paper a paper cotton stock having a basis weight of approximately 80 g/m² for making banknotes in a method of Berger et al since Sunberg teaches that a paper cotton stock having a basis weight of approximately 80 g/m² may be used for making banknotes.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy
Examiner
Art Unit 1762

August 1, 2003